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10/663,045	09/13/2003	David J. Laverick	702.276	1970
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GARMIN LTD.			DIACOU, ARI M	
C/O GARMIN INTERNATIONAL, INC.				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,045	<b>Applicant(s)</b> LAVERICK ET AL.
	<b>Examiner</b> ARI M. DIACOU	<b>Art Unit</b> 3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 October 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 23-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1668)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the arguments in the Appeal Brief filed on 10-31-2007,

PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Jack W. Keith/

Supervisory Patent Examiner, Art Unit 3663.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schoenfish et al. (USP No. 6370037).

- Regarding claim 1, Schoenfish discloses a navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:
  - a portable navigational device; [Fig. 1, #12] and
  - a mounting assembly [Fig. 1, #10] for mounting on a support pillar of the vehicle [Fig. 1, #68] and sized and configured to removably receive [Figs. 2-3] the navigational device [#12], wherein the navigation device remains visible when received within the mounting assembly [Fig. 3] and is functional as a navigation device both when received within the mounting assembly [Fig. 3] and when being used independently of the mounting assembly [Fig. 5].

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish (USP No. 6370037) in view of Sturt (USP No. 2003/0184111). Schoenfish discloses a navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:

- a portable navigational device; [Fig. 1, #12] and
- a mounting assembly [Fig. 1, #10] for mounting on a vehicle [Fig. 1, #68] and sized and configured to removably receive [Figs. 2-3] the navigational device

[#12], wherein the navigation device remains visible when received within the mounting assembly [Fig. 3] and is functional as a navigation device both when received within the mounting assembly [Fig. 3] and when being used independently of the mounting assembly [Fig. 5].

but fails to disclose mounting the mounting assembly to a support pillar on a vehicle. Sturt teaches a method of securing a navigation device 18 [¶ 0022] to the roof of a vehicle including retainer #26, which reads on applicant's support pillar. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical or ergonomic engineer) at the time the invention was made, to combine the detachable electronic mounting apparatus of Schoenfish with the overhead console of Sturt by mounting the apparatus #10 of Schoenfish to the retainer #26 of Sturt as suggested in Col. 4, lines 37-38, for the advantage of using the electronic devices enumerated in [0023] of Sturt or [Col 1, lines 18-23] of Schoenfish inside or outside of the vehicle of Sturt as suggested by Schoenfish [Col. 1, lines 24-45].

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish or Schoenfish in view of Sturt as applied to claim 1 above. Schoenfish discloses the invention with all the limitations of claim 1, but fails to disclose explicitly that the electronic devices 12 described in column 3, lines 9-20 are made to fit the 14, 16 and 70 which are installed in he vehicle, or if 14, 16 and 70 are configured to fit electronic device 12. Schoenfish does teach various possibilities of electronic device, and refers to a the apparatus 10, as 14 and 16, implying that 14 an 16 are designed

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after the electronic device housing. [Col. 3, lines 8-19]. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to have a navigational device "that is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle", for the advantage of increasing consumer choice (any electronic device) and reducing consumer cost (modification costs less than a new electronic device with a custom housing).

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish or Schoenfish in view of Sturt as applied to claim 1 above, and further in view of Meade's catalogue (NPL). Schoenfish discloses the invention with all the limitations of claim 1, but fails to disclose explicitly that the electronic devices 12 described in column 3, lines 9-20 are made to fit the 14, 16 and 70 which are installed in the vehicle, or if 14, 16 and 70 are configured to fit electronic device 12. Meade teaches a two phase coupler that attaches a camera to a telescope. "the T-Adapter threads to the rear cell of the telescope, followed by a T-mount appropriate to the user's brand of 35mm camera. In this way the camera body is rigidly coupled to the telescope's optical system, which in effect becomes the camera's lens." [Page 2]. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to have a navigational device "that is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle", for the advantage of increasing consumer choice (any

electronic device) and reducing consumer cost (modification costs less than a new electronic device with a custom housing).

10. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish and Sturt or Schoenfish, Sturt and Meade as applied to claim 2 above. Schoenfish and Sturt (and possibly Meade) disclose the invention with all the limitations of claim 2.

- Regarding claim 3, Sturt discloses an overhead console system 10 [0022], and a infotainment system 18 [0023] with its screen facing left. That implies that eyes are facing right, which implies that the windshield is on the right, which means that , it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to place the retainer 26 directly above the windshield, as suggested by Sturt.
- Regarding claim 4, Sturt discloses wherein the mounting assembly includes -
  - a trim piece, [Fig. 1, #21]
  - a base secured to the trim, [line in Fig. 1 surrounding 18, 16 and 16]and Schoenfish discloses:
  - a base secured to the trim, [Fig. 1, #68]
  - a docking station mounted within the base, [Fig. 1, #16] and
  - a retractable face plate mounted within the docking station [Fig. 1, #14]
- Regarding claim 5, Schoenfish discloses that windows 22 and 60 are for electrical connections. [Col. 4, lines 43-45]

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- Regarding claim 6, Sturt discloses that 18 may be an audiovisual infotainment system [0005] and navigation systems [0033], therefore it would have been obvious to one skilled in the art (e.g. an ergonomic engineer) at the time the invention was made, to use an audible navigation device (which would be included by the docking station) for providing audible navigation instructions, for the advantage of preserving the driver's visual attention on the road.
- Regarding claim 7, the limitations thereof are inherent to all GPS devices.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish (USP No. 6370037) in view of Sturt (USP No. 2003/0184111). Schoenfish discloses a navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:

- a stand-alone hand-held portable navigational device; [Fig. 1, #12] and
- a mounting assembly [Fig. 1, #10] for mounting on the vehicle [Fig. 1, #68] and sized and configured to mate [Figs. 2-3] and removably receive the navigational device [#12], such that the navigation device remains visible and fully functional when received within the mounting assembly [Fig. 3]

but fails to disclose mounting the mounting assembly to a support pillar on a vehicle.

Sturt teaches a method of securing a navigation device 18 [¶ 0022] to the roof of a vehicle including retainer #26, which reads on applicant's support pillar. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical or ergonomic engineer) at the time the invention was made, to combine the detachable electronic

mounting apparatus of Schoenfish with the overhead console of Sturt by mounting the apparatus #10 of Schoenfish to the retainer #26 of Sturt as suggested in Col. 4, lines 37-38, for the advantage of using the electronic devices enumerated in [0023] of Sturt or [Col 1, lines 18-23] of Schoenfish inside or outside of the vehicle of Sturt as suggested by Schoenfish [Col. 1, lines 24-45].

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish or Schoenfish in view of Sturt as applied to claim 1 above. Schoenfish discloses the invention with all the limitations of claim 24, but fails to disclose explicitly that the electronic devices 12 described in column 3, lines 9-20 are made to fit the 14, 16 and 70 which are installed in he vehicle, or if 14, 16 and 70 are configured to fit electronic device 12. Schoenfish does teach various possibilities of electronic device, and refers to a the apparatus 10, as 14 and 16, implying that 14 an 16 are designed after the electronic device housing. [Col. 3, lines 8-19]. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to have a navigational device "that is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle", for the advantage of increasing consumer choice (any electronic device) and reducing consumer cost (modification costs less than a new electronic device with a custom housing).

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish or Schoenfish in view of Sturt as applied to claim 1 above, and further in view of Meade's catalogue (NPL). Schoenfish discloses the invention with all the limitations of claim 24, but fails to disclose explicitly that the electronic devices 12 described in column 3, lines 9-20 are made to fit the 14, 16 and 70 which are installed in the vehicle, or if 14, 16 and 70 are configured to fit electronic device 12. Meade teaches a two phase coupler that attaches a camera to a telescope. "the T-Adapter threads to the rear cell of the telescope, followed by a T-mount appropriate to the user's brand of 35mm camera. In this way the camera body is rigidly coupled to the telescope's optical system, which in effect becomes the camera's lens." [Page 2]. Therefore, it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to have a navigational device "that is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle", for the advantage of increasing consumer choice (any electronic device) and reducing consumer cost (modification costs less than a new electronic device with a custom housing).

14. Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish and Sturt or Schoenfish, Sturt and Meade as applied to claim 2 above. Schoenfish and Sturt (and possibly Meade) disclose the invention with all the limitations of claim 2.

- Regarding claim 26, Sturt discloses an overhead console system 10 [0022], and a infotainment system 18 [0023] with its screen facing left. That implies that eyes are facing right, which implies that the windshiled is on the right, which means that , it would have been obvious to one skilled in the art (e.g. a mechanical engineer) at the time the invention was made, to place the retainer 26 directly above the windshield, as suggested by Sturt.
- Regarding claim 27, Sturt discloses wherein the mounting assembly includes -
  - a trim piece, [Fig. 1, #21]
  - a base secured to the trim, [line in Fig. 1 surrounding 18, 16 and 16]

and Schoenfish discloses:

- a base secured to the trim, [Fig. 1, #68]
- a docking station [Fig. 1, #16] mounted within the base [Fig. 1, #68] and designed to conform to the shape of the navigation device [Fig. 2], and
- a retractable face plate [Fig. 1, #14] mounted within the docking station [Fig. 2] and operable to retract when the navigation device is received within the docking station [Col. 4, lines 45-63] and extend when the navigation device is removed from the docking station, [Col. 5, lines 9-18] thereby covering the void left in the docking station
- Regarding claim 29, Schoenfish discloses that windows 22 and 60 are for electrical connections. [Col. 4, lines 43-45]
- Regarding claim 28, Sturt discloses that 18 may be an audiovisual infotainment system [0005] and navigation systems [0033], therefore it would have been

obvious to one skilled in the art (e.g. an ergonomic engineer) at the time the invention was made, to use an audible navigation device (which would be included by the docking station) for providing audible navigation instructions, for the advantage of preserving the driver's visual attention on the road.

- Regarding claim 30, the limitations thereof are inherent to all GPS devices.

### ***Conclusion***

15. The references made herein are done so for the convenience of the applicant. They are in no way intended to be limiting. The prior art should be considered in its entirety.

16. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/AMD/

28-Jan-08

/Deandra M Hughes/

Primary Examiner, Art Unit 3663